

Application Serial No. 10/010,292

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Date December 4, 2003

Reply to Office Action dated October 1, 2003

REMARKS

In the "Final" Office Action dated October 1, 2003, the specification is objected to. Claims 1 and 3-14 are rejected under 35 U.S.C. § 102(b).

However, for the following reasons, it is respectfully submitted that Applicants' invention as set forth in the claims and specification is particularly pointed out and claimed in a manner to distinguish it from each of the references cited by the Examiner. Reconsideration and entry of this Amendment under the provisions of Rule 37 C.F.R. 1.116 is respectfully requested.

The Examiner includes claim 3 in each rejection. It is pointed out that claim 3 was cancelled in the response filed on August 22, 2003.

The specification is objected to as failing to provide proper antecedent basis for the use of the term "monolithically" in claim 1. The Examiner contends that this term is not defined by the original specification.

However, it is submitted that ample case law exists to enable an applicant to claim an invention in a manner consistent with the originally filed specification, claims and/or drawing. It is submitted that the specification can be amended to incorporate a written description of the function inherently disclosed in the drawings as originally filed. In cases involving predictable factors, such as mechanical or electrical elements, a single embodiment provides broad enablement in the sense that, once imagined, other embodiments can be made without difficulty and their performance characteristics predicated by resort to known scientific laws. See *In re Fisher*, 427 F.2d 833, 166 USPQ 18 (C.C.P.A. 1970). The C.C.P.A. has described the general test for determining whether a drawing can constitute an adequate written description of the invention under §112, first paragraph as follows:

The practical, legitimate enquiry in each case of this kind is what the drawing in fact discloses to one skilled in the art. Whatever it does disclose may be added to the specification in words without violation of the statute and rule which prohibit "new matter," 35 U.S.C. 132, Rule 118, for the simple reason *that what is* originally disclosed cannot be "new matter" within the meaning of this law. If the drawing, then, contains the necessary disclosure, it *can* "form the basis of a valid claim."

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See *in re* Wolfensperger, 302 F.2d 950, 133 USPQ 537 (C.C.P.A. 1962) (emphases in original). The C.C.P.A. has also stated the following general rule for determining when subject matter is inherently disclosed in the specification:

By disclosing in a patent application a device that inherently performs a function, operates according to a theory, or has an advantage, a patent applicant necessarily discloses that function, theory or advantage even though he says nothing concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter.

See *in re* Smythe, 480 F.2d 1376, 178 USPQ 279, 295 (C.C.P.A. 1973).

Therefore, the specification and claims of the present application can be amended to include a written description of the invention consistent with that disclosed in the original drawing figures as set forth in the amended claims to be presented. The term "monolithically" is defined in Webster's Unabridged Dictionary as "consisting of one piece, solid or unbroken." Second, Applicants' contend that they are entitled to use the term monolithically as it clearly defines the invention as set forth in paragraph 45 wherein the contact members are defined as being in the form of one or more projections which are integrally formed with the housing to be a unitary part thereof.

The Examiner notes that the specification fails to define the term monolithically and, therefore, the Examiner interprets it to mean "integrally formed" as defined in paragraphs 44 and 45 of the specification. However, the Examiner appears to be interpreting the term "integrally" as stated in the Office Action in a manner inconsistent with Applicants' description in paragraph 45 and in the drawing as the contact members in the cited references, while mounted on a connector part, are not integrally formed as a unitary of the same part of the connector in the manner defined by the Applicants and shown in the drawing.

Thus, it is submitted that the use of the term "monolithically" is permitted as it clearly defines this feature of Applicants' invention as shown in the original drawing.

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Claims 1, 6-9 and 12-13 are rejected under 35 U.S.C. §102(b) as being anticipated by Naito. This is the same rejection raised by the Examiner in the first Office Action and appears to be based on an interpretation of the term "integrally" as the Examiner interprets "monolithically" to be merely a part of. The Examiner is overlooking Applicants' use of this term, as embodied in the more descriptive term "monolithically" as being a one piece unitary part of the housing, that is, formed as part of the housing. In Naito, the contact members in the hose are annular metallic conductors having one portion mounted axially on the housing and an end portion disposed angularly over the end of the housing for contact with a mating contact member carried in a mating connector part when the two connector ends are abutted. The two connector ends in Naito are not formed so that one is insertable into the other. Nor do the connector members of Naito have a contact member monolithically formed on the housing and disposed in the bore of the housing to contact the other member inserted into the bores.

For this reason, it is respectfully submitted that Applicants' invention as set forth in claims 1, 2, 6-9, 12 and 13 includes features which are not taught or anticipated by Naito.

Claims 1, 2 and 4-13 are rejected under 35 U.S.C. §102(b) as being anticipated by Cunningham. The Examiner bases this rejection on Cunningham on the same grounds as stated in the previous Office Action. In Cunningham, the contact members comprise discrete metallic pins and contact members carried in two different parts of the drill pipe which are brought into contact with each other when the separate drill pipe parts are interconnected. While the pins and contacts are carried by the pipe parts, they are not "monolithically" or "integrally" formed with the parts as defined by the Applicants' in the specification, claim 1 and the drawing. The contact members in Cunningham are clearly separate members mounted in the drill pipe parts. While the contact members in Cunningham are carried by the drill pipe parts, they do not meet the definition of "monolithically" or "integrally" as used to define the contact member and housing of Applicants' invention.

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For these reasons, it is respectfully submitted that Applicants' invention as set forth in claims 1, 2 and 4-13 includes features which are not anticipated by Cunningham.

With respect to claims 6 and 7, it is respectfully submitted that Cunningham fails to disclose contact members which have an inner diameter smaller than an outer diameter of a male endform or which are positioned in the bore in the housing for engagement with the tip end of the male endform as set forth by the Applicants. Thus, Applicants' invention as set forth in claims 6, and 7 is submitted to patentably define over Cunningham in its own right.

In summary, for the reasons set forth above, it is respectfully submitted that Applicants' are entitled to use the term "monolithically" to define the formation of the contact member and the housing as such is clearly consistent with the original drawing and more clearly defines this feature of Applicants' invention. Further, for the reasons set forth above, it is respectfully submitted that Applicants' invention as set forth in claims 1, 2, and 4-13, includes features which are not anticipated by either of the cited references. Thus, it is submitted that claims 1, 2, 4-14 are in condition for allowance; a notice of which is respectfully requested.

Entry of this Amendment are the provisions of Rule 37 C.F.R. 1.116 is submitted to be warranted and is respectfully requested.

The amendments to claim 1 are submitted to place claim 1, as well as all claims depending therefrom, in allowable condition by overcoming all the objections and rejections raised by the Examiner. Alternately, it is further submitted that the amendments to claim 1 place the claims in better condition for an appeal in the event that the Examiner does not allow any of the claims.

The amendments to claim 1 are submitted solely to more clearly define Applicants' invention even though it was believed that Applicants' invention was adequately defined in the previous form of claim 1. Further, it is submitted that the amendment to claim 1 does not introduce new subject matter or elements which would require undue consideration or even a further search by the Examiner.

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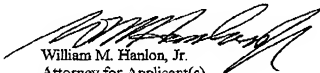
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For these reasons, it is submitted that this Amendment meets all of the requirements of Rule 37 C.F.R. 1.116 for entry and consideration of an Amendment after a "Final" Office Action.

If the Examiner, after considering this Amendment, believes that further amendments are necessary to place the claims in allowable condition, he is invited to contact Applicants' attorney at the below-listed telephone number.

Respectfully submitted,

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